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10/542,012	07/12/2005	Tsuyoshi Tsuchiya	P28141	8934
7055 7590 02/07/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER JARRETT, RYAN A	
			ART UNIT	PAPER NUMBER
			2125	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		02/07/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/07/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/542,012

Applicant(s)

TSUCHIYA ET AL.

Examiner

Ryan A. Jarrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/04/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 5-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 01/08/2007.

2. Applicant's election with traverse of claims 1-4 and 10-17 in the reply filed on 01/08/2007 is acknowledged. The traversal is on the ground(s) that there has been no showing regarding serious burden. This is not found persuasive because this is not a required showing for National Stage applications. Even if it were, Examiner submits there is a serious burden since the two inventions do not share the same or corresponding special technical feature, as detailed in the prior Office Action. As such, a completely different search strategy, including classification search strategy and text search strategy, would have to be employed.

Applicants also argue that the power tool record use memory is an essential feature of both groups. First, this is not true since Group I does not require a power tool record use memory, per se. This is because Group I is not directed to a power tool at all. Rather, it is directed to a software/computer system external to a power tool. A power tool is not positively recited in Group I. Second, even if the groups did share this feature, a power tool record use memory is simple not "special", as evidenced by the

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prior art of record. The requirement is still deemed proper and is therefore made FINAL.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 11/04/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

5. The abstract of the disclosure is objected to because the first word is not capitalized. Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities:

On page 14 line 3, it appears that "based of" should be changed to "based on".

On page 18 line 19, it appears that "or" should be inserted before "a way of using".

Appropriate correction is required.

Drawings

7. The drawings are objected to because in Fig. 6 #S13, "B2" should be changed to "B4", per pg. 14 line 22 of the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-4 and 10-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, 10, and 14, the specification does not disclose how to "estimate a work description by using the data concerning use record".

Applicant has disclosed several working example of the "data concerning the use record" in the specification. For example, the "data concerning the use record" includes data such as working time during a period from turn-on to turn-off of a switch of the power tool, resting time during a period from a turn-off to next turn-on of the switch, a number of times when the switch is turned on, a maximum current value and an average current value of currents flowing to a motor during the working time.

However, Applicant has apparently provided no working examples of what the "work description" is, or how it is "estimated" using the data concerning the use record.

In response to this rejection, Applicant is respectfully request to provide:

- 1) at least one working example of the claimed "work description", and

2) an explanation of how the "work description" is "estimated" using the data concerning the use record.

Claims 2-4, 11-13, and 15-17 depend from claims 1, 10, and 14, and incorporate the same deficiencies.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-4 and 10-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "an estimated work description" in line 17. It appears that this should be changed to "the estimated work description" for proper antecedent basis, since it appears to be referring to the previously estimated work description already recited in the claim.

Claim 10 recites the limitation "an estimated work description" in line 12. It appears that this should be changed to "the estimated work description" for proper antecedent basis, since it appears to be referring to the previously estimated work description already recited in the claim.

Claim 11 recites the limitation "the switch" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "an estimated work description" in line 13. It appears that this should be changed to "the estimated work description" for proper

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antecedent basis, since it appears to be referring to the previously estimated work description already recited in the claim.

Claim 15 recites the limitation "the switch" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claims 2-4, 12-13, and 16-17 depend from claims 1, 10, and 14 and incorporate the same deficiencies.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 3-4, 10-13, and 16-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

14. Claims 3, 12, and 16 are generally directed to an abstract idea (§101 judicial exception). For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea. Diehr, 450 U.S. at 187, 209 USPQ at 8; Benson, 409 U.S. at 71, 175 USPQ at 676.

To satisfy section 101 requirements, the claim must be for a practical application of the §101 judicial exception, which can be identified in various ways: (1) The claimed invention “transforms” an article or physical object to a different state or thing, or (2) The claimed invention otherwise produces a useful, concrete and tangible result.

Practical Application by Physical Transformation

In the present case, claims 3, 12, and 16 not “transform” an article or physical object to a different state or thing.

Practical Application That Produces a Useful, Concrete, and Tangible Result

For eligibility analysis, physical transformation “is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application.” AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. In determining whether the claim is for a “practical application”, the focus is not on whether

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the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is “useful, tangible and concrete”.

Claims 3, 12, and 16 are directed to a system, program, and recording medium for “selecting models”. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result.

Specifically, the claimed subject matter of does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter of claims 3, 12, and 16 provide for “selecting models”. This produced result remains in the abstract and, thus, fails to achieve the required status of having real world value. The act of “selecting” can be considered a thought, computation, or data manipulation.

Where the final result is what has been determined, calculated, selected, decided, adjusted, tracked, etc. without using what has been determined, calculated, selected, decided, adjusted, tracked, etc. in a disclosed practical application or at least making what has been determined, calculated, selected, decided, adjusted, tracked, etc. available for use through some form of conveyance (for example display, print,

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sound, transmission, etc.) or at least temporary storage somewhere, then a tangible result has not been achieved.

Although claims 3, 12, and 16 are directed to a system, program, and recording medium, respectively, it is noted that machines, processes and, by logical extension, instructions carried by computer readable media or carrier signals that perform or would perform a method that constitutes solely an abstract concept do not manifest a "practical application" required for being a statutory claim.

Claims 4, 13, and 17 are rejected by virtue of their dependency from claims 3, 12, and 16. Claims 4, 13, and 17 would rectify the aforementioned deficiencies of claims 3, 12, and 16, since they recite a tangible final result of "displaying remaining lifetime or replacement time of the secondary battery pack".

This rejection to claims 3, 12, and 16 could be overcome by reciting that the selected models of the secondary battery pack and/or battery charger are displayed by the display unit, as disclosed in the specification on page 19 lines 21-23. The rejection to claims 3, 12, and 16 could also be overcome by "rolling up" claims 4, 13, and 17, respectively.

15. Claims 10-13 are directed functional descriptive material, or software per se.

This rejection could be overcome by reciting a "computer readable medium" storing the claimed "program". However, it is noted that this change would make claim 10 virtually identical to claim 14. Thus, it appears that claims 10-13 should just be cancelled.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1, 10, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore et al. US 4,896,273.

For example, Moore et al. discloses:

14. **A recording medium that records a program for assisting selection of power tool which selects and presents a power tool suitable for work description of the user by being read and run in a computer therein, the program comprising:**

a step for reading out data concerning a model or specification of the power tool and data concerning a use record from a memory provided in the power tool (e.g., col. 7 line 41 – col. 8 line 2: “The specifications of the saw blade, including the length, width, gage, tooth set, and teeth per inch, as well as the operating characteristics of the band saw actually measured”, claim 1: “entering into a microprocessor that is coupled to the ROM identifying parameters about a particular band saw and a particular workpiece”);

a step for estimating a work description by using the data concerning use record read out from the memory (e.g., col. 7 line 41 – col. 8 line 2: “when cutting substantially identical items”, col. 9 lines 1-4: “The appropriate thickness of the workpiece is then entered into the computer, either by actually measuring the workpiece or estimating”);

a step for judging whether the model or specification of the power tool is suitable for the estimated work description or not (e.g., col. 7 line 41 – col. 8 line 2: “The specifications of the saw blade, including the length, width, gage, tooth set, and teeth per inch, as well as the operating characteristics of the band saw actually measured, are compared to the schedules of predetermined parameters”);

a step for selecting a model of the power tool with a specification suitable for an estimated work description among previously stored models of the power tools when it is judged that the model or specification of the power tool is not suitable for the estimated work description (e.g., col. 7 line 41 – col. 8 line 2: “As a result of this comparison, a recommendation is provided as to the optimum saw blade and optimum operating characteristics, such as blade speed and cutting speed when cutting the substantially identical items, claim 1: “selecting data identifying an optimum blade for the particular band saw and the particular workpiece according to the identifying parameters”); **and**

a step for displaying a result of judgment and the selected model of the power tool (e.g., claim 1: “displaying information identifying the optimum blade”).

18. Claims 1, 10, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Barker et al. US 6,021,360.

For example, Barker et al. discloses:

14. **A recording medium that records a program for assisting selection of power tool which selects and presents a power tool suitable for work description of the user by being read and run in a computer therein, the program comprising:**

a step for reading out data concerning a model or specification of the power tool and data concerning a use record from a memory provided in the power tool (e.g., claim 1: “retrieving tool and process usage data and tool-specific data based on a chosen tool and process history of said chosen tool”);

a step for estimating a work description by using the data concerning use record read out from the memory (e.g., claim 1: “calculating a production parameter from said tool and process usage data”);

a step for judging whether the model or specification of the power tool is suitable for the estimated work description or not (e.g., claim 1: “comparing said production parameter to a limit included in said tool-specific data including said process history of said chosen tool, and selectively permitting or preventing use of said chosen tool in accordance with a result of said comparing step”);

a step for selecting a model of the power tool with a specification suitable for an estimated work description among previously stored models of the power tools when it is judged that the model or specification of the power tool is not suitable for the estimated work description (e.g., claim 10: “retrieving tool-specific data for another tool when a chosen

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tool for a process is not defined”, col. 5 lines 24-34: “assisting in the choice of tool and warning the operator or preventing use of a particular tool”, col. 8 lines 18-23: “a warning is issued to the operator in any desired manner (e.g., display, annunciator, or the like) and use of the tool is allowed...the operator is preferably provided with the option to substitute another tool in response to the warning”, col. 9 lines 5-15: “useful guidance and information is provided to the operator to assist in the choice of an alternate tool”); **and**

a step for displaying a result of judgment and the selected model of the power tool (e.g., col. 5 lines 24-34: “assisting in the choice of tool and warning the operator or preventing use of a particular tool”, col. 8 lines 18-23: “a warning is issued to the operator in any desired manner (e.g., display, annunciator, or the like) and use of the tool is allowed...the operator is preferably provided with the option to substitute another tool in response to the warning”, col. 9 lines 5-15: “useful guidance and information is provided to the operator to assist in the choice of an alternate tool”).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 2, 11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. as applied to claims 1, 10, and 15 above, and further in view of Brotto et al. US 7,138,785, Wagner et al. US 5,903,462, and Johnson et al. US 2006/0091858.

Moore et al. discloses:

15. **The recording medium that records a program for assisting selection of a power tool therein in accordance with claim 14, wherein the data concerning the use record includes working time during a period from turn-on to turn-off of the switch (e.g., col. 2 lines 56-68: "The apparatus is configured to record and display such parameters as the actual time for a particular machine cycle or cutting cycle"), ~~resting time during a period from turn-off to next turn-on of the switch, a number of times when the switch is turned on, a maximum current value (e.g., col. 8 line 7: "maximum amps") and an average current value of currents flowing to a motor during the working time.~~**

Moore et al. does not explicitly disclose that the data concerning the use record includes resting time during a period from turn-off to next turn-on of the switch, a number of times when the switch is turned on, or an average current value of currents flowing to a motor during the working time.

Brotto et al. discloses a power tool with means for obtaining product use information including a working time during a period from turn-on to turn-off of a switch and a number of times that the switch is turned on (e.g., col. 2 lines 55-67, col. 4 lines 46-58).

Wagner et al. discloses an apparatus for controlling a hand-held tool comprising storing data in the tool concerning a use record including a resting time during a period from turn-off to next turn-on of the switch (e.g., col. 2 lines 5-8, col. 4 lines 9-60).

Johnson et al. discloses a power tool comprising a memory storing average current value a currents flowing to a motor during a working time (e.g., [0238]).

Moore et al., Brotto et al., Wagner et al., and Johnson et al. are analogous art since all are directed to power tools comprising memories for storing use records therein.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the power tool memory of Moore et al. to include the specific data disclosed by Brotto et al., Wagner et al. and Johnson et al. in order to confirm that the power tool of Moore et al. is performing within defined specifications for that particular power tool, as taught by each of these references.

Allowable Subject Matter

21. Any potential indication of allowable subject matter with respect to claims 3-4, 12-13, and 16-17 is being held in abeyance pending correction of the rejection(s) under 35 U.S.C. 112 1st paragraph, 35 U.S.C. 112 2nd paragraph, and 35 U.S.C. 101 set forth in this Office action.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan A. Jarrett whose telephone number is (571) 272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ryan A. Jarrett
Examiner
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2/2/07